

REMARKS

In the Action, claims 1-6 and 11 are rejected, and claims 7-10 are withdrawn from consideration as being directed to the non-elected invention. In response, claim 1 is amended to include the subject matter of original claim 11, and new claims 12-17 are added.

New claims 12-14 depend from claim 1 and recite the topical tyrosinase inhibitor defining the amount of the fragrance, UV absorbing agent and R2 being a straight chain or branched saturated or unsaturated alkyl having 2 to 5 carbon atoms. Claims 15-17 depend from claims 3-5, respectively, and define R3 as methyl as in claim 1. These claims are supported by the specification as originally filed.

Claims 7-10 are withdrawn from consideration as being directed to the non-elected invention. Applicants respectfully submit that claims 7-10 should be examined as depending directly from claim 1. The claims are directed to the process of using the compound of claims 1 and 2, and thus, incorporate the substance of claims 1 and 2. A proper search would overlap with the subject matter of claim 1 and would not create an unreasonable burden on examination. Accordingly, Applicants respectfully submit that claims 7-10 should be rejoined in this application.

In view of these amendments and the following comments, reconsideration and allowance are requested.

The Rejections

Claims 1 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by the article by Yamamura et al. as evidenced by WO 00/56279 to Collington. Yamamura et al. is cited for

disclosing various dihydric phenols. Collington is cited for disclosing that resorcinol derivatives and tyrosinase inhibitors can be used for lightening skin and reducing the pigmentation of skin.

Yamamura et al. does not anticipate the claims as amended. Yamamura et al. does not disclose a topical tyrosinase inhibitor composition as recited in claim 1. Yamamura et al. refers generally to the antioxidant activities of various dihydric phenol derivatives. Yamamura et al. does not disclose or suggest that the compounds function as a tyrosinase inhibitor or exhibit any tyrosinase activity. Furthermore, Yamamura et al. does not disclose or suggest a composition as defined in claim 1 having tyrosinase inhibitor activity.

The Action refers generally to Collington. Collington discloses a single compound for reducing pigmentation of skin. The single compound disclosed in Collington is a cyclohexanol derivative, and thus, does not fall within the compounds disclosed in Yamamura et al. or the present invention. The single compound disclosed in Collington does not provide a reasonable basis to suggest that all resorcinol derivatives inherently have a skin lightening effect. Collington is not relevant to the claimed invention or Yamamura et al. Accordingly, Collington does not establish that Yamamura et al. anticipates the claims.

Claim 1 is further amended to recite the topical tyrosinase inhibitor composition including at least one member selected from the group consisting of a fragrance, a compound for care and/or cleansing of skin and/or hair and a UV absorbing agent. Yamamura et al. clearly does not disclose or suggest a composition containing these components, either alone or in combination with a compound of Formula I. Yamamura et al. provides no suggestion to one skilled in the art that the compounds have a tyrosinase inhibiting action or a skin whitening action. Accordingly, claim 1 is not anticipated.

Claim 6 is also not anticipated by Yamamura et al. for reciting a process of preparing an agent for the treatment against skin and hair browning, for combating age spots and/or for inhibiting the undesired browning of foods. Claim 6 recites the step of adding to the agent for the treatment against skin and hair browning, combating age spots and/or for the inhibition of undesired browning of foods by adding to the agent a compound of Formula I. Yamamura et al. discloses various compounds *per se* but does not suggest that any of the disclosed compounds are suitable for the treatment against skin and hair browning, combating age spots and/or inhibiting the undesired browning of foods. Yamamura et al. only discloses that the compounds exhibit antioxidant activity. Yamamura et al. does not disclose adding the compounds of Formula I to an agent as defined in claim 1. Accordingly, the process for prepare an agent for treating against skin and hair browning, combating age spots and inhibiting undesired browning of foods of claim 1 is not anticipated by Yamamura et al.

Claim 6 is also rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants respectfully submit that claim 6 is not indefinite. Claim 6 is amended to specifically recite the step of adding the compound of Formula I to the agent for the treatment against skin and hair browning, combating age spots and inhibiting undesired browning of foods. Thus, claim 6 is not indefinite to one of ordinary skill in the art. The claims are not required to specifically define “how” to prepare the agent. Accordingly, claim 6 is not indefinite.

Claims 1, 2, 6 and 11 are provisionally rejected for obviousness-type double patenting over claims 1, 2 and 12 of copending application Serial No. 12/159,886. Claims 1, 2 and 6 are provisionally rejected for obviousness-type double patenting over claims 1-5, 17 and 19 of copending application Serial No. 12/159,866. Claims 1, 2 and 11 are also rejected for obviousness-type double patenting over claim 1 of copending application Serial No. 12/159,951.

Applicants respectfully submit that the claims as amended are not obvious over the copending applications. The claims of the copending applications do not render the claimed topical tyrosinase inhibitor composition of claim 1 which includes a compound of Formula I and at least one member selected from the group consisting of a fragrance, a compound for care and/or cleansing of skin and/or hair, and a UV absorbing agent obvious to one of ordinary skill in the art. Accordingly, Applicants respectfully request these rejections be withdrawn.

Claims 1-6 and 11 are rejected under 35 U.S.C. § 103(a) as being obvious over JP 11-255637 to Kondo et al. in view of Yamamura et al. Kondo et al. is directed to cosmetics that include a resorcinol derivative as a tyrosinase activity inhibitor. Kondo et al. is specifically directed to resorcinol derivatives that are substituted in the 4-position as disclosed in paragraph 0004. Kondo et al. is directed to a limited number of resorcinol derivatives having complex substituents in the 4-position. Kondo et al. does not disclose or suggest any compounds that fall within the scope of Formula I of claims 1 and 6. Kondo et al. provides no suggestion to one skilled in the art and provides no reasonable expectation that the compounds as defined in Formula I of claims 1 and 6 would exhibit tyrosinase inhibiting activity.

As noted above, Yamamura et al. does not disclose or suggest to one skilled in the art that any of the compound disclosed in Yamamura et al. exhibit tyrosinase inhibiting activity. The Action provides no reasonable basis for the position that it would have been obvious to one skilled in the art to provide a topical tyrosinase inhibitor composition as in claim 1 to include a compound of Yamamura et al. One skilled in the art would have no reasonable expectation that any of the compounds in Yamamura et al. would exhibit tyrosinase inhibiting activity without extensive experimentation.

The Action suggests that it would have been obvious to substitute the compounds of Yamamura et al. since the compounds are homopolymers. The claims are not directed to the compound of Formula I *per se*, but instead are directed to a tyrosinase inhibiting composition comprising a compound of Formula I and a fragrance, a compound for care and/or cleansing of skin and/or hair, and a UV absorbing agent. Furthermore, the Action provides no basis that one of ordinary skill in the art would have any expectation that the homopolymers would exhibit tyrosinase activity. Kondo et al. is specifically directed to resorcinol derivatives having a specifically defined substituent in the 4-position on the phenol ring. Kondo et al. does not disclose or suggest that all substituents on the 4-position exhibit tyrosinase activity. Kondo et al. provides no suggestion that the compound identified by Formula I in Kondo et al. can be modified in the manner suggested in the Action and still provide the desired tyrosinase inhibiting activity. Kondo et al. only discloses that certain substituents in the 4-position are able to provide tyrosinase inhibiting activity.

One skilled in the art would not have a reasonable expectation that modifying the compounds of Kondo et al. would result in a composition exhibiting tyrosinase inhibiting activity. Yamamura et al. as noted above does not suggest to one skilled in the art that any of the compounds exhibit tyrosinase activity. Furthermore, the Action provides no evidence that the broad class of compounds disclosed in Yamamura et al. exhibit tyrosinase inhibiting activity. Yamamura et al. discloses 46 different compounds, none of which overlap with the compounds disclosed in Kondo et al. or the claimed invention. Of the 46 different compounds disclosed in Yamamura et al., only two of the compounds are related structurally to the compounds of Formula I. One skilled in the art in reviewing Yamamura et al. and/or Kondo et al. would have no expectation that any of the compounds of Yamamura et al. would exhibit tyrosinase inhibiting

activity. Furthermore, the random selection of two compounds disclosed in Yamamura et al. does not render the claimed topical tyrosinase inhibitor composition obvious to one of ordinary skill in the art. Yamamura et al. and Kondo et al. provide no suggestion of a topical tyrosinase inhibitor composition as defined in claims 1 and 2.

Yamamura et al. and Kondo et al. also do not disclose a fragrance composition. Accordingly, it would not have been obvious to one of ordinary skill in the art to provide a fragrance composition comprising a fragrance in an amount to provide a sensory effect and one or more compounds of Formula I as recited in claim 3. Kondo et al. and Yamamura et al. also do not suggest a cosmetic formulation comprising one or more compounds for the care and/or cleansing of skin and/or hair, and one or more compounds of Formula I as in claim 4, or a sunscreen formulation comprising an effective amount of a UV filter and one or more compounds of Formula I as in claim 5.

Yamamura et al. and Kondo et al. further fail to disclose a process for preparing an agent for the treatment against skin and hair browning, combating age spots and/or inhibiting the undesired browning of foods by adding a compound of Formula I to an agent as in claim 6.

In view of these amendments and the following comments, Applicants respectfully submit that the claims are in condition for allowance. Accordingly, reconsideration and allowance are requested.

Respectfully submitted,



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